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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,855	04/28/2006	David William Taylor	127865	4856
25944	7590	09/01/2009		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER BHAT, ADITYA S	
			ART UNIT 2863	PAPER NUMBER
			MAIL DATE 09/01/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/577,855	TAYLOR, DAVID WILLIAM	
	<b>Examiner</b>	<b>Art Unit</b>	
	ADITYA BHAT	2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status***

1. Claims 1-12 are currently pending in this application. Claims 1-12 are rejected under 35 U.S.C. 102(e)

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/30/2009 has been entered.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

4. The drawings submitted on 4/28/2006 are in compliance with 37 CFR § 1.81 and 37 CFR § 1.83 and have been accepted by the examiner.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**6.** Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by

Agrorio US 6,697,096

With regards to claim 1, Agrorio US 6,697,096 teaches a method of scanning comprising the steps of:

providing a scanning system having a sample holder(108) and a relatively movable scanning device, the sample holder having a rotatable or longitudinal axis; ( Col. 1, lines 55 & 60)

performing a scan of at least a part of an object located on the sample holder and of at least a portion of a surface of the sample holder; ( Col. 1, lines 60-63)

using data from the scan, establishing orientation of a plane of the sample holder and thereby establishing misalignment or non-colinearity of the sample holder with respect to the rotatable or longitudinal axis; (Col. 4, lines 12-42) and

interpreting data from the scan using the orientation of the sample holder in order to correct the data for any misalignment or non-colinearity. (Col. 10, lines 3-10)

With regards to claim 2, Agrorio US 6,697,096 teaches the orientation is established by defining a plane of the sample holder. (Col. 3, lines 33-37)

With regards to claim 3, Agrorio US 6,697,096 teaches the plane in which orientation is established is limited by boundaries. (ends of the holder is interpreted as the limits; figure 1)

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With regards to claim 5, Agrorio US 6,697,096 teaches the orientation is established by extracting data for **at least** 240 degrees around the surface of the sample holder. (236;figure 1) measures in a circular direction (360 degrees)

If applicant believes that measuring 240 degrees to be novel applicant should explain why this specific angular measurement would provide unexpected results or why this specific angle is novel in view of the prior art.

With regards to claim 6, Agrorio US 6,697,096 teaches the orientation is established by measuring during a single process. (Col. 5, lines 54-56)

With regards to claim 7, Agrorio US 6,697,096 teaches the orientation is established by measuring during more than one discrete processes. (Col. 5, lines 54-56)

With regards to claim 8, Agrorio US 6,697,096 teaches the orientation is established within a defined vertical envelope with respect to the sample holder. (space b/w 244 & 104/108;figure 1)

With regards to claims 9-10, Agrorio US 6,697,096 teaches a method of scanning comprising:

providing a scanning system having a sample holder(108) the sample holder having a rotatable or longitudinal axis; (figure 1) and

a relatively movable scanning device; (236figure 1)

performing a datum scan; ( Col. 1, lines 55 & 60) (figure 1)

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performing a sample scan; ( Col. 1, lines 60-63)and interpreting data from the sample scan using misalignment or non-colinearity data from the datum scan in order to correct the data for any misalignment or non-colinearity. (Col. 10, lines 3-10);

wherein the scanning system automatically carries out the datum and sample scans. (Col. 3, lines 46-50)

With regards to claims 11-12, Agrorio US 6,697,096 teaches the scan of the object and the scan of at least a portion of the sample holder are conducted as a single scan. (Col. 3, lines 46-50)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Agrorio US 6,697,096.

With regards to claim 4, Agrorio US 6,697,096 teaches the orientation is established by extracting at least three measurements. (Col. 5, lines 54-55)

Agrorio US 6,697,096 teaches taking measurements at actual locations. Thus one of ordinary skill in the art could conclude that multiple measurements have been taken. While the exact number of measurements is not equal to that claimed by applicant, applicant has failed to show the criticality of taking three measurements as opposed to taking multiple (2 or more) measurements. Therefore, it is examiners

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position that the number of measurements taken by the prior art is functionally equivalent to that of the claimed invention.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection. .

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADITYA BHAT whose telephone number is (571)272-2270. The examiner can normally be reached on 9:30-5:30.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aditya Bhat/

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August 30, 2009